

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**Docket Number (Optional)  
058268.00080

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
Name \_\_\_\_\_

Application Number:

09/982,794

Filed: October 22, 2001

First Named Inventor:

Shih-Hsiung NI

Art Unit: 2151

Examiner: Kamal B. Divecha

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under  
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.  
Registration No. \_\_\_\_\_

☐ Attorney or agent acting under 37 CFR 1.34.  
Registration Number if acting under 37 CFR 1.34 58,823

Signature

Kamran Emdadi

Typed or printed name

703-720.7822

Telephone number

October 10, 2008

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

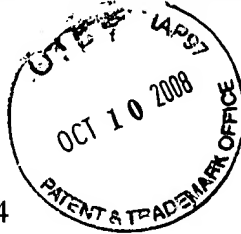
In re the Application of:

Shih-Hsiung NI

Application No.: 09/982,794

Filed: October 22, 2001

For: DATA PATH OPTIMIZATION ALGORITHM



Confirmation No.: 8401

Art Unit: 2151

Examiner: K.B. DIVECHA

Attorney Dkt. No.: 058268.00080

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

October 10, 2008

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicant hereby submits this Pre-Appeal Brief Request for Review of the final rejections of claims 1-13 in the above identified application. Claims 1-13 were finally rejected in the Office Action dated July 11, 2008. Applicant filed a Response to the Final Office Action on September 15, 2008, and the Office issued an Advisory Action dated September 25, 2008 maintaining the final rejections of claims 1-13. Applicant hereby appeals these rejections and submit this Pre-Appeal Brief Request for Review because the rejections contain clear error.

The Office Action rejected claims 1-4, 6-8, and 10-12 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over Thompson (European Publication No. EP 0572145 A2) ("Thompson") in view of Scott (U.S. Patent No. 6,512,773) ("Scott"), and further in view of Parruck, *et al.* (U.S. Patent No. 7,139,271) ("Parruck"). According to the Office Action, Thompson teaches all of the elements of claims 1-4, 6-8 and 10-12 except for a data packet including a plurality of cells including a header cell, wherein the header cell of the plurality of cells includes a header and a packet data portion and a counter to determine the number of bytes of a packet after the header has been removed. Thus, the Office Action used Scott and Parruck to cure the deficiencies of Thompson in an effort to yield the combination of elements recited in claims 1-4, 6-8 and 10-12. The rejection contains clear errors and fails to disclose each of the features

clearly recited in claims 1-4, 6-8 and 10-12.

Initially, Applicant notes that page 13 of the Office Action mailed on July 11, 2008 admitted that Thompson fails to disclose or suggest “a counter configured to determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell”, as recited, in part, in independent claim 1 and similarly in independent claims 6 and 10. Applicant agrees that Thompson fails to disclose the above-noted claim features of claims 1, 6 and 10. However, Applicant disagrees that Scott cures those deficiencies of Thompson. Therefore, a detailed discussion of the deficiencies of Scott is described in detail below.

Claim 1 recites, in part, “a counter configured to determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell.” Similar claim recitations are also recited in independent claims 6 and 10. The Office Action relied on column 10, lines 40-50 and FIG. 5 of Scott as allegedly disclosing this feature of the claims. Applicant disagrees that Scott discloses determining whether the header cell of a data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell.

Column 10, lines 40-50 of Scott discloses

“In block 231, the payload (105a of FIG. 4A) is processed from the frame 100. The number of octets of the user data PDU 71 of the payload is counted in block 232. This value forms the length field of the AAL5 CS. Note that the user data PDU 71 is the field found after the 4-octet ATM header field 91 of FIG. 4A. Block 234 forms the UU and CPI fields of the AAL5 frame. For the case where the UU and CPI field are not included in the header or trailer, the default “0” is used. Block 236 adds pad characters to make the AAL5 frame equal an integer number of 48 octet cells. In block 237, the 32 bit cyclic redundancy check (CRC) of the AAL5 frame is calculated. Block 238 segments the above AAL5 frame into an integer number of 48 octet cells.”

As can be clearly observed from column 10, lines 40-50 of Scott the only part of the frame 100 that is “counted” is the “User Data PDU” (i.e., 71) portion of the payload 105a. In other words, the “4 octet ATM header” (i.e., 91) is not part of the counting operation performed by Scott. The only counting performed in Scott is the counting of the number of octets of the user data included in the payload 71.

The determined number of octets is used for the length field of the ATM adaptation layer-5 convergence sub-layer (AAL5 CS). The counting of the data octets in only the payload portion of the data packet is again reinforced in operation 232 of FIG. 5C of Scott (i.e., the only “count” related operation). Once the segmentation of the 48 octet cells of data are prepared (operation 238), then the 4 octet ATM header is extracted from the frame and HEC is added to create the 5 octet ATM header (operation 241). The 5 octet ATM header is then combined with the 48 octet payload to create a conventional 53 octet ATM cell (operation 244).

Scott does not disclose using a counter or performing a counting operation to determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell. The only operations that Scott performs after the header is extracted in operation 239 of FIG. 5C is adding the HEC to the header, adding the header back to the 48 octet payload, and appending a “last cell indicator” for the last cell (see operations 239-244 of FIG. 5C). Therefore, contrary to the position alleged on lines 1-5 of page 2 of the Advisory Action dated September 25, 2008, Scott does not disclose or suggest “a counter configured to determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell”, as recited, in part, in independent claim 1 and similarly in independent claims 6 and 10.

Furthermore, Applicant submits that the additional arguments provided on lines 1-8 of page 2 of the Advisory Action dated September 25, 2008 are without merit. As noted above, Scott fails to disclose certain claim recitations of independent claims 1, 6 and 10. In addition to those deficiencies of Scott, the Office Action has alleged that the *KSR Int. v. Teleflex* decision supports the rejection. Applicant submits that the statements on lines 5 and 6 of the Advisory Action wrongfully concluded that the counter in Scott “is fully capable of counting whether the header cell of the packet...” As noted above, there is no disclosure in Scott of counting a header portion of the packet. Additionally, the *KSR* decision has not changed the three-prong requirements required to establish a prima facie case of obviousness, especially, the prong that the combination of references must teach each and every feature recited in the claims. *KSR* has nothing to do with the requirement that each claim recitation be properly taught by the prior art references. Therefore, *KSR* cannot be used to fill the gap missing in Scott that the counter “determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell.”

In addition to the above-noted deficiencies of Scott and Thompson, Parruck also fails to cure the deficiencies of Thompson and Scott with respect to the pending claims.

Parruck discloses that a large ATM cell is divided into individual cells, each of the individual cells include a header and a payload portion. Each data packet is divided into multiple header cells because each cell includes header and payload portions. There is no disclosure or suggestion in Parruck of “a counter configured to determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell”, as recited, in part, in independent claim 1 and similarly in independent claims 6 and 10.

Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. §103(a) contains clear error and should be withdrawn because neither Thompson, Scott nor Parruck, whether taken singly or combined, teaches or suggests each feature of claims 1, 6 and 10. Each of claims 2-4, 7-8 and 11-12 depend on claims 1, 6 and 10 and should be allowed at least because of their dependence on claims 1, 6 and 10, in addition to the further limitations recited in claims 2-4, 7-8 and 11-12. The failure to teach each of the claim recitations of the pending claims demonstrates that a *prima facie* case of obviousness has not been established. The rejections of claims 1-4, 6-8 and 10-12 contain clear error and must be withdrawn.

Claims 5, 9 and 13 were rejected under 35 U.S.C. 103(a) as being obvious over Thompson in view of Scott and further in view of Parruck and U.S. Patent No. 6,697,873 B1 to Yik. According to the Office Action, Thompson, Scott and Parruck teach all of the elements of claims 5, 9 and 13 except for teaching that the medium access control protocol module has a MAC address for transmitting the modified cell of the data packet and a layer two switching module configured to build a table for forwarding rules upon which the MAC address exists. Therefore, the Office Action combined the teachings of Yik with Thompson, Scott and Parruck to allegedly yield all of the elements of claims 5, 9 and 13. The rejection is traversed for containing clear error for being based on references that neither teach nor suggest the novel combination of features clearly recited in independent claims 1, 6 and 10, upon which claims 5, 9 and 13 depend.

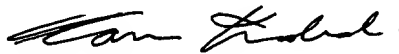
Yik also does not cure the deficiencies of Thompson, Scott and/or Parruck, as outlined above. Yik teaches an apparatus and method for storing and searching computer node addresses in a computer network system. Each of claims 5, 9 and 13 depend on claims 1, 6 and 10 respectively, and thus, incorporates all of the elements of the independent claims.

There is no teaching or suggestion in Yik of "a counter configured to determine whether the header cell of the data packet contains a multiple of a predetermined number of bytes after the header has been removed from the header cell", as recited, in part, in independent claim 1 and similarly in independent claims 6 and 10, upon which claims 5, 9 and 13 depend. Therefore, the rejection under 35 U.S.C. §103(a) contain clear error and must be withdrawn because neither Thompson, Scott, Parruck nor Yik, whether taken singly or combined, teaches or suggests each feature of claims 1, 6 and 10. Each of claims 5, 9 and 13 depend on claims 1, 6 and 10 and should be allowed at least because of their dependence on claims 1, 6 and 10, in addition to the further limitations recited in claims 5, 9 and 13.

As noted previously, claims 1-13 recite subject matter which is neither disclosed nor suggested in the prior art references cited in the Office Action. It is therefore respectfully requested that all of claims 1-13 be allowed, and this application passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



---

Kamran Emdadi  
Registration No. 58,823

**Customer No. 32294**  
SQUIRE, SANDERS & DEMPSEY LLP  
14<sup>TH</sup> Floor  
8000 Towers Crescent Drive  
Vienna, Virginia 22182-6212  
Telephone: 703-720-7800  
Fax: 703-720-7802  
KE:sjm

Enclosures: PTO/SB/33 Form  
Notice of Appeal  
Check No. 19766